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15 **UNITED STATES DISTRICT COURT**  
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**CENTRAL DISTRICT OF CALIFORNIA**

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18 **LFP IP, LLC,** } Case No.: cv 16-166 FFM  
19 vs. } Plaintiff, } The Hon. Frederick F. Mumm  
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21 **LEE KEITH BRETT,** } [Proposed] **FINAL PRETRIAL**  
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28 **CONFERENCE ORDER**

**Final Status Conference: September 13,  
2018**  
**First Day of Trial: October 2, 2018**

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**FINAL PRETRIAL CONFERENCE ORDER**

1           Following pretrial proceedings, pursuant to F.R.Civ.P. 16 and L.R. 16, IT IS  
2 ORDERED:

3           1. The parties are: Plaintiff LFP IP, LLC (“Plaintiff”), and  
4           Defendant Lee Keith Brett (“Defendant”).  
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6           Each of these parties has been served and has appeared. All other  
7           parties named in the pleadings and not identified in the preceding paragraph are  
8           now dismissed.  
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10           The pleadings which raise the issues are:  
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12           The Complaint filed by Plaintiff on January 8, 2016 (Doc. 1);  
13

14           and  
15

16           the Answer filed by Defendant on August 3, 2016 (Doc. 23)  
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20           2. Federal jurisdiction and venue are invoked upon the grounds:  
21           Plaintiff seeks injunctive relief under 15 U.S.C. § 1051, *et seq.* (the “Lanham  
22           Act”), and this Court has subject matter jurisdiction of this action pursuant to 28  
23           U.S.C. §§ 1331; 1332; 1338 and 1367; 15 U.S.C. § 1125(a); and 15 U.S.C. §  
24           1121. Venue is proper pursuant to 28 U.S.C. §§ 1391 (b) and (c).  
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28           3. The trial is estimated to take 2 trial days.

4. The trial is to be a non-jury trial.

At least seven (7) days prior to the trial date the parties shall file and serve by e-mail, fax or personal delivery the findings of fact and conclusions of law the party expects the Court to make upon proof at the time of trial required by L.R.

52-1.

5. The following facts are admitted and require no proof:

(1) Plaintiff LFP IP, LLC (“Plaintiff”) is a Delaware limited liability company authorized to do business in the State of California.

(2) Plaintiff is the owner of a HUSTLER trademark that was registered on February 25, 2003 for “clothing, namely, beach wear, blouses, coats, coveralls, dresses, head wear, jackets, jeans, jogging suits, jumpers, leg warmers, leggings, lingerie, lounge wear, neckwear, pants, scarves, shirts, ski wear, slacks, sleep wear, tank tops, socks, vests” in International Class 25 (U.S. Reg. No. 2689852).

(3) Plaintiff is the owner of a HUSTLER HOLLYWOOD service mark

1 that was registered on April 2, 2013 for “[r]etail store services featuring  
2 digital video discs, adult sexual stimulation aids, apparel, lingerie, hats,  
3 cosmetics, candles, perfumes, shave creams, bath and body products,  
4 personal lubricants, body creams, novelty items, party games, playing  
5 cards, candies, jewelry, books, magazines, condoms, and lotions” in  
6 International Class 35 (U.S. Reg. 4312312).  
7  
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9  
10 (4) Plaintiff is the owner of a HUSTLER trademark that was registered  
11 on May 20, 1975 for “entertainment magazine” in International Class 16  
12 (U.S. Reg. 1011001).  
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16 (5) Plaintiff is the owner of a HUSTLER TV trademark that was  
17 registered on October 25, 2005 for “[c]able, satellite, television and video-  
18 on-demand (VOD) broadcasting” in International Class 38 (U.S. Reg.  
19 3008950).  
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23 (6) Plaintiff is the owner of a HUSTLER trademark that was registered  
24 on January 28, 2003 for “men's and women's jewelry, namely, rings,  
25 necklaces, bracelets, [watches]” in International Class 14 and “glassware,  
26 namely, shot glasses, mugs, beer steins” in International Class 21 (U.S.  
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**FINAL PRETRIAL CONFERENCE ORDER**

1 Reg. 2679483).  
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4 (7) Plaintiff is the owner of a HUSTLER trademark that was registered  
5 on December 4, 2007 for “[g]arments for pets” in International Class 18  
6 (U.S. Reg. 3349195).

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9 (8) Plaintiff is the owner of a HUSTLER trademark that was registered  
10 on February 15, 2011 for “[m]otorcycle helmets” in International Class 9.  
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12 (U.S. Reg. 3918404).

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15 (9) Plaintiff is the owner of a HUSTLER trademark that was registered  
16 on December 24, 2013 for “[e]yewear, namely, sunglasses; Protective gear  
17 for motorcycle riding, namely, motorcycle gloves for protecting hands in  
18 an accident and motorcycle goggles” in International Class 9. (U.S. Reg.  
19  
20 4453481).

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23 (10) Plaintiff is the owner of a HUSTLER trademark that was registered  
24 on June 18, 2013 for “[b]ackpacks; Duffel bags; Handbags; Messenger  
25 bags; Purses; Tote bags; Travel bags; Wallets” in International Class 18.  
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27 (U.S. Reg. 4354035).

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2 (11) Defendant Lee Keith Brett (“Defendant”) is an individual that  
3 resides in Clay Center, Kansas.

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7 (12) Defendant operates a website with the domain name  
8 <AmericanHustlerClothing.com>

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11 (13) Defendant purchased the <AmericanHustlerClothing.com> domain  
12 name on or about May 7, 2015.

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15 (14) Defendant filed a trademark application on June 10, 2015, for an  
16 AMERICAN HUSTLER service mark (Serial No. 86657943) for “[o]n-  
17 line retail stores services featuring clothing and billiard products” in  
18 International Class 35.

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22 (15) During the application process, Defendant disclaimed any exclusive  
23 right to use “AMERICAN” apart from the mark as shown.

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27 (16) On October 22, 2015, the United States Patent and Trademark  
28 Office (“USPTO”) issued an Office Action refusing Defendant’s

1 AMERICAN HUSTLER application based upon the likelihood of  
2 confusion with three of Plaintiff's Registered Marks (specifically, U.S.  
3 Reg. Nos. 2689852, 4268341, and 4312312).

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7 (17) On December 8, 2015, Defendant responded to the October 22, 2015  
8 Office Action.

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11 (18) On January 10, 2016, the USPTO issued a Final Office Action again  
12 refusing Defendant's AMERICAN HUSTLER application based upon the  
13 likelihood of confusion with Plaintiff's Registered Marks (specifically,  
14 U.S. Reg. Nos. 2689852, 4268341, and 4312312).

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18 (19) On June 22, 2016, prior to this preliminary conclusion being fully  
19 adjudicated, the USPTO suspended action on Defendant's AMERICAN  
20 HUSTLER application pending termination of this civil proceeding and the  
21 refusal for likelihood of confusion with Plaintiff's Registered Marks was  
22 continued as non-final.

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26 (20) LFP, IP is not the exclusive trademark owner of the word "hustler."  
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28 For example, Cigar Hustler reg. no. 4337913 is not owned by LFP, IP.

1 (21) LFP, IP has not conducted a survey.  
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5       6. The following facts, though stipulated, shall be without prejudice to  
6 any evidentiary objection: N/A  
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11       **7. Plaintiff:**  
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13       (a) Plaintiff plans to pursue the following claims against the following  
14 defendant:  
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16       Claim 1: Defendant infringed Plaintiff's Registered Trademark(s) by  
17 promoting, advertising, preparing to distribute and/or selling "American  
18 Hustler" branded clothing items (15 U.S.C. § 1114(a)).  
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21       Claim 2: Defendant, in connection with the sale of t-shirts, used the  
22 term "American Hustler" in a false or misleading way which is likely to  
23 cause confusion, or to cause mistake, or to deceive as to the affiliation,  
24 connection or association between Defendant and Plaintiff, or as to the  
25 origin, sponsorship or approval of Defendant's t-shirts or commercial  
26 activities by Plaintiff (15 U.S.C. § 1125(a)).  
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The elements required to establish Plaintiff's claims are:

Claim 1: Infringement of Plaintiff's Registered Trademark

A trademark is any word, name, symbol, device, or any combination thereof, used by a person to identify and distinguish that person's goods from those of others and to indicate the source of the goods.

In this case, Plaintiff contends that the Defendant has infringed Plaintiff's trademark(s). Plaintiff has the burden of proving by a preponderance of the evidence that:

- (1) HUSTLER® and/or HUSTLER HOLLYWOOD® are valid, protectable trademarks;
  - (2) Plaintiff owns the HUSTLER® and/or HUSTLER HOLLYWOOD® trademarks; and
  - (3) Defendant used the “American Hustler” mark on his goods, without the consent of the Plaintiff, in a manner that is likely to cause confusion among ordinary purchasers as to the source of the goods.

AUTHORITY: Ninth Circuit Manual of Model Jury Instructions,  
§15.1[modified] and §15.5 [modified].

1           Claim 2:     Federal Unfair Competition / False Designation of Origin  
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3           Plaintiff has the burden of proving by a preponderance of the evidence  
4           that:

- 5           (1)       The HUSTLER® and/or HUSTLER HOLLYWOOD® trademarks  
6           are valid, protectable marks;
- 7           (2)       Plaintiff owns the claimed trademarks;
- 8           (3)       Defendant used the “American Hustler” mark, without the consent  
9           of Plaintiff, in a manner that is likely to cause confusion among ordinary  
10          consumers as to the source, sponsorship, affiliation or approval of the  
11          goods.

12           AUTHORITY: 15 U.S.C. §1125 (a)

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19           In brief, the key evidence Plaintiff relies on for each of the claims is:  
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- 21           1.       Plaintiff’s Federal Trademark and Service Mark Registrations  
22           (Plaintiff owns various HUSTLER® trademark registrations for various  
23           goods and services, including but not limited to an incontestable  
24           registration for apparel items, including shirts. Plaintiff also owns the  
25           HUSTLER HOLLYWOOD® service mark for a chain of retail stores that  
26           feature various items for sale, including but not limited to HUSTLER®

branded t-shirts and HUSTLER® branded merchandise).

2. Examples of Plaintiff LFP's T-Shirts (various designs that Plaintiff has sold over the years, some that feature the American flag and the slogan "Hardcore Since '74").

3. Defendant's various T-Shirt Designs (among other things, Defendant's t-shirt designs that feature "Hustler" prominently, designs that feature the year 1974, and using words such "original").

4. The USPTO's rejection of Defendant's "American Hustler" service mark application on a Section 2(d) likelihood of confusion refusal basis with respect to several registrations owned by Plaintiff.

5. Defendant's website that features various "American Hustler" t-shirt designs.

**Defendant:**

(a) Defendant plans to pursue the following counterclaims and

1 affirmative defenses:

2 Pursuant to the meet and confer process with LFP's counsel, and based in  
3 particular on LFP's counsel's representations that it will not pursue a claim for  
4 damages, and has withdrawn and will not pursue its Third and Fourth Claims  
5 asserted in the Complaint, Mr. Brett will not pursue at trial the following defenses  
6 previously asserted in Mr. Brett's answer, affirmative defenses and counterclaims  
7 are withdrawn: 1) estoppel; 2) license; 3) laches; 4) waiver; 5) failure to state a  
8 claim; 6) mitigation of damages. On August 3, Mr. Brett withdrew two  
9 counterclaims asserted in the Answer. See ECF No. 30.

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15 (b) The elements required to establish Defendant's counterclaims and  
16 affirmative defenses are: See response to (a) above.

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20 (c) In brief, the key evidence Defendant relies on for each counterclaim  
21 and affirmative defense is: See response to (a) above.

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24 8. In view of the admitted facts and the elements required to establish  
25 the claims, counterclaims and affirmative defenses, the following issues remain  
26 to be tried: (1) whether Defendant used the "American Hustler" mark on his  
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1 goods, without the consent of the Plaintiff, in a manner that is likely to cause  
2 confusion among ordinary purchasers as to the source of the goods; and (2)  
3 Defendant used the “American Hustler” mark, without the consent of Plaintiff,  
4 in a manner that is likely to cause confusion among ordinary consumers as to the  
5 source, sponsorship, affiliation or approval of the goods  
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10 9. All discovery is complete.  
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15 10. All disclosures under F.R.Civ.P. 26(a)(3) have been made.  
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17 The joint exhibit list of the parties has been filed under separate cover as  
18 required by L.R. 16-6.1.  
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20 Pursuant to the Civil Trial Order issued on June 26, 2018, the parties shall  
21 meet and confer and prepare the Final Pre-Trial Exhibit Stipulation for filing on  
22 September 25, 2018.  
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25 11. Witness lists of the parties have been filed with the Court.  
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27 Only the witnesses identified in the lists will be permitted to testify (other  
28 than solely for impeachment).

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2       12. The following law and motion matters and motions in limine, and no  
3       others, are pending or contemplated: N/A.  
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10      13. Bifurcation of the following issues for trial is ordered: None.  
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16      14. The foregoing admissions having been made by the parties, and the  
17       parties having specified the foregoing issues remaining to be litigated, this Final  
18       Pretrial Conference Order shall supersede the pleadings and govern the course  
19       of the trial of this cause, unless modified to prevent manifest injustice.  
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Dated: \_\_\_\_\_, 2018.

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U.S. DISTRICT MAGISTRATE JUDGE

1  
2 Approved as to form and content.  
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4 ***Attorneys for Plaintiff LFP IP, LLC:***  
5

6 LIPSITZ GREEN SCIME CAMBRIA LLP  
7

8 By: /s/Jonathan W. Brown  
9 Jonathan W. Brown, Esq.  
10

11 ***Attorneys for Defendant Lee Keith Brett:***  
12

13 McDERMOTT WILL & EMERY LLP  
14

15 By: /s/ Jodi L. Benassi  
16 Jodi L. Benassi, Esq.  
17

18 **SIGNATURE ATTESTATION**  
19

20 Pursuant to Local Rule 5-4.3.4, I hereby attest that all other signatories  
21 listed, and on whose behalf the filing is submitted, concur in the filing's content  
22 and have authorized the filing.

23 By: /s/Jonathan W. Brown  
24

25 Jonathan W. Brown  
26 Attorney for Plaintiff  
27 LFP IP, LLC  
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